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Paper No. 20

BERNARD H BROWNE JR
240 SAND KEY ESTATES DRIVE # 68
CLEARWATER FL 33767-2932

COPY MAILED

MAY 08 2003

OFFICE OF PETITIONS

In re Application of
Bernard H. Browne
Application No. 09/655,792
Filed: September 6, 2000
Title: INSTANT MUSICIAN, RECORDING
ARTIST AND COMPOSER

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ON PETITION

This is a decision on the renewed petition under 37 CFR 1.137(a), filed November 19, 2002 ("dated" November 15, 2002).

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The above-identified application became abandoned for failure to timely file a **proper** response to the final Office action mailed October 4, 2001, which set a shortened statutory period for reply of three months.¹ Petitioner filed an amendment on January 15, 2002, made timely by including a Certificate of Mailing dated December 24, 2002.² However, the examiner determined that the amendment did not *prima facie* place the application in condition for allowance. Accordingly, an Advisory Action was mailed on February 13, 2002, informing petitioner that the amendment would not be entered because it failed to comply with 37 CFR 1.121. No further proper reply with an appropriate extension of time was

¹ A **proper** reply to a **final** Office action consists of the filing of either an amendment that *prima facie* places the application in condition for allowance, a Notice of Appeal, a continuing application or a Request for Continued Examination (RCE).

² Correspondence filed with the USPTO is filed: 1) on the date it is **received** in the Office, or 2) the date the correspondence is deposited with the United States Postal Service via "Express Mail Service". See 37 CFR 1.6 and 37 CFR 1.10. Here, petitioner did not deposit the amendment via USPS Express Mail. However, petitioner included a Certificate of Mailing dated December 24, 2001 with his amendment (not to be confused with USPS "Certified Mail"). Accordingly, although the amendment was not "filed" until January 15, 2002 (the date of receipt), it is "considered as being timely filed" on December 24, 2001. See 37 CFR 1.8.

received. Petitioner could have filed a proper reply together with the maximum obtainable three month extension of time as late as April 4, 2002. However, petitioner did not file a proper reply with the appropriate extension of time. Accordingly, the above-identified application became abandoned on January 5, 2001. A Notice of Abandonment was mailed on May 23, 2002. Petitioner filed a petition to revive under 37 CFR 1.137(a) and 37 CFR 1.137(b) on August 12, 2002. However, these petitions were dismissed in a decision mailed on October 3, 2002.

Consideration of petition under 1.137(a) (Unavoidable Delay):

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The instant petition does not satisfy requirement (3) or (1).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable: "The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."³

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the MPEP, however, does not constitute "unavoidable" delay.⁴

The decision now turns to petitioner's arguments presented on renewed petition.

"Timely Response to Advisory Action (Item 8) Could Only Have Been Met By Turning Back Clocks Several Weeks"

Petitioner's argument does not reveal a proper understanding of the rules relating to extensions of time. The final Office action that was mailed on October 4, 2001 set a "shortened" statutory period for reply of three months. The final Office action also informed petitioner that extensions of time under 37 CFR 1.136(a) were available. However, the final Office action instructed petitioner that in "no event" could a reply be filed

³ In re Mattulath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

⁴ See Haines, 673 F. Supp. at 317, 5 U.S.P.Q. 2d at 1132; Vincent v. Mossinghoff, 230 U.S.P.Q. 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 U.S.P.Q. 1091 (D.D.C. 1981); Potter v. Dann, 201 U.S.P.Q. 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

after six months. Therefore, the last day petitioner could have filed a reply to the final Office action **without** an extension of time would have been January 4, 2002; the last day petitioner could have filed a reply to the final Office action **with** the maximum three month extension of time would have been April 4, 2002.

The Advisory Action mailed on February 13, 2002 did **not** set a new period for reply. Instead, it stated the period for reply expires three months from the mailing date of the final Office action (October 4, 2001). As did the final Office action, the Advisory Action reminded petitioner that extensions of time were available. Accordingly, after the Advisory Action was mailed, petitioner could have filed a response to the October 4, 2001 Office action as late as March 4, 2002 with a two month extension of time, or April 4, 2002 with a three month extension of time.

Petitioner did not timely file a proper response with an appropriate extension of time.

"Amended Application Was Filed 5/23/01, Not on 01/15/02"

Petitioner states that the amendment "mailed on 12/24/01 (item 6) responded properly to all of the items requested." Such statement does not reveal a proper understanding of the rules that relate to final rejections. 37 CFR 1.113 states that "reply to a final rejection or action must include **cancellation of, or appeal** from the rejection of, each rejected claim."⁵ In other words, an amendment after final rejection is not the time for an applicant to make further arguments to the examiner. Rather, the applicant must place the application in condition for allowance by canceling the rejected claims, or file a Notice of Appeal (the filing of a continuation application or an RCE is also permissible practice). Here, applicant merely filed an amendment, without filing a Notice of Appeal, a continuation application, or an RCE. Accordingly, applicant assumed the risk that the examiner would determine that the amendment after final did not place the application in condition for allowance. As informed in the Advisory Action mailed February 13, 2002, this was indeed the case.

"Rule 37 CFR 1.121 Was Not in Effect When Application Was First Filed"

Petitioner states that he "was not aware of any new patent rules that came into effect after he filed his application." As stated above, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the MPEP does not constitute "unavoidable" delay.

"Advisory Action Very Untimely and Impossible to Meet Timing"

As stated above, petitioner still had time to file a response to the final Office action mailed October 4, 2001. Petitioner could have filed a response (an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, a

⁵ Emphasis added.

continuation application, or an RCE) as late as April 4, 2002 with a three month extension of time.

"Late Fee Request By USPTO Was in Error and Should Be Refunded"

Applicant's response to the final Office action was filed on January 15, 2002. However, the response contained a Certificate of Mailing dated December 24, 2002.⁶ Accordingly, the response is "considered to be timely", even though it was not filed until January 15, 2002. Therefore, applicant is correct - no extension of time is needed. Applicant will be refunded the one month extension of time fee, or \$55.

"Incorrect Statements by USPTO in Oct 3, 2002 "Decision Dismissing Petitions"

This decision will now address petitioner's contention that numerous "incorrect statements" were made in the October 3, 2002 dismissal.

"Petition Under 37 CFR 1.137(a) Unavoidable OR (b) Unintentional - Not Both"

Petitioner argues that he should not have been charged for both a petition under 37 CFR 1.137(a) and 37 CFR 1.137(b). Rather, the USPTO should have accepted the one which "was most appropriate to apply." **However, the Manual of Patent Examining Procedure states that petition fees are "required for the filing (and not merely the grant) of a petition under 37 CFR 1.137."**⁷ Therefore, for the Office to even **consider** petitioner's argument under 37 CFR 1.137(a), the \$55 fee was necessary. Likewise, for the Office to **consider** petitioner's argument under 37 CFR 1.137(b), the \$640 petition fee was necessary.

"There was Not a Failure to File a Timely Reply to the Final Office Action"

Petitioner argues that the application did not become abandoned for failure to file a reply to the October 4, 2001 final Office action because he "mailed a 24 page response" on December 24, 2001. However, the issue is not whether petitioner timely file a response. The issue, and the reason the application became abandoned, is because petitioner did not file a **proper** response. As stated above, a proper response would have consisted of an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, a continuation application, or an RCE. Applicant's response was determined by the examiner not to *prima facie* place the application in condition for allowance.

⁶ The Certificate of Mailing was the language reading "I hereby certify that this correspondence is being deposited with the United States Postal Service as Priority Mail in an envelope mailed to U.S. Department of Commerce, Patent and Trademark Office, Assistant Commissioner for Patents, Stanley Witkowski, Primary Examiner, Washington DC 20231 on this date of December 24, 2001".

⁷ MPEP 711.03(c) (III).

"Shortened Statutory Period for Reply Was Met by Inventor"

The Office does not dispute that petitioner filed a response on January 15, 2002, made timely by including a Certificate of Mailing dated December 24, 2001. As explained in the paragraph above, petitioner's response was not **proper**.

"Amendment Was Not Filed on January 15, 2002"

As explained in footnote 2 of this decision, correspondence filed with the USPTO is filed on either the date it is received in this Office, or the date it is deposited with the USPS via "Express Mail". However, if an applicant includes a timely "Certificate of Mailing" under 37 CFR 1.8, correspondence will be considered to be timely filed in the Office, even if it is not received until after a period set forth for reply.

"One Month Extension of Time Not Submitted on January 15, 2002 as Stated"

Petitioner is correct. The fee for the one month extension of time on January 15, 2002 was not necessary, since petitioner included a Certificate of Mailing dated December 24, 2001.

"Another Amendment Was Not Untimely Filed on May 3, 2002"

On May 3, 2002, petitioner filed another amendment. However, as this amendment was outside the maximum six month period for reply (only available with a three month extension of time, which petitioner did not obtain), the amendment was not timely and could not have been considered by the examiner, even if it was a proper response (the examiner has now indicated it was **not** a proper response).

"Application Was Not Abandoned Effective February 5, 2002"

The application in fact became abandoned on January 5, 2002, due to petitioner's failure to file a timely and **proper** reply to the October 4, 2001 final Office action.

"Notice of Abandonment Mailing Date Error"

Petitioner points out that the Notice of Abandonment was mailed on May 23, 2002, not May 3, 2002 as stated in the October 3, 2002 dismissal. Petitioner is correct.

"Petitioner Maintaining that the Delay Was Unavoidable Was Not Strictly Correct"

As stated above, for the USPTO to even **consider** petitioner's argument under 37 CFR 1.137(a) (unavoidable delay), the filing \$55 petition fee was necessary. The USPTO next considered petitioner's argument under 37 CFR 1.137(b) (unintentional delay). To consider this, the filing of a \$640 petition fee was necessary.

"Petitioner Logically Believed New Period Was Set For Final Response"

Petitioner states that "there was no other logical conclusion

that could have been made". If petitioner were familiar with the rules governing extensions of time (37 CFR 1.136(a)), petitioner would have reached the correct conclusion. In fact, the Advisory Action itself stated that extensions of time may be obtained.

"Advisory Action on New Rule Mailed Almost Nine Months After Amendment Filed"

Petitioner argues that there was no Advisory Action mailed for the amendment filed May 29, 2001 (mailed on May 23, 2001). It is not Office practice to mail Advisory Actions for amendments submitted in response to a **non-final** Office Action.

"Late Fee Requested by the USPTO When Nothing Was Late"

Petitioner is correct as stated above, and the \$55 fee for the one month extension of time will be refunded.

"Absolute Proof on Mailing Delays"

Petitioner is correct - there was a delay from the day petitioner mailed his after-final amendment (December 24, 2001) and the day it was filed (received) in the Office (January 15, 2002). Regardless of the delay, petitioner's amendment was considered to be timely because it included a Certificate of Mailing dated December 24, 2001.

"Replies to All Outstanding Office Actions Were Filed"

Petitioner has provided a summary of actions in "Table 1", showing differences in dates in "actual mailing dates by the inventor and the dates erroneously stated by the USPTO." There is a difference between when correspondence by an applicant is **mailed** and when correspondence is **filed**, or received by the USPTO. The filing date is the date that correspondence is received in the Office, or the date the correspondence is deposited via USPS "Express Mail". Petitioner has not demonstrated that he filed any correspondence via USPS "Express Mail". Accordingly, petitioner's past correspondence was filed on the date of receipt.

"Petition Fee Set Forth in 37 CFR 1.17(1) Was Paid"

The decision on petition mailed October 3, 2002 never stated otherwise.

"Entire Delay Was Unavoidable"

The delay was not unavoidable. The abandonment could have been avoided by filing a Notice of Appeal together with the amendment filed on January 15, 2002, such that when the examiner did not enter the amendment, he would have entered the Notice of Appeal. Furthermore, after receiving the Advisory Action mailed February 13, 2002, the abandonment could have been avoided by filing a proper reply (Notice of Appeal, amendment *prima facie* placing the application in condition for allowance, continuation application, or an RCE) with an appropriate extension of time.

"Disclaimer and Fee Not Required"

Petitioner is correct - a terminal disclaimer is not required. The phrase "any terminal disclaimer" (as opposed to "a terminal disclaimer") was used to suggest that it only need be submitted if required. Accordingly, the fee submitted for a terminal disclaimer will be refunded to petitioner.

"Burden of Proof Upon Inventor"

As already set forth above, petitioner has still not met his burden of proof with regards to unavoidable delay.

"No More or Greater Care or Diligence than Is Generally Used and Observed by Prudent and Careful Men in Relation to Their Most Important Business"

With respect to reviving an application under 37 CFR 1.137(a) (unavoidable delay), a petitioner **must** show that he acted in such a manner that a prudent and careful man would act in relation to his most important business. Here, a prudent and careful man would have familiarized himself with the applicable laws and regulations concerning that business. It is immaterial that petitioner's business is writing and publishing, and not filing patents. Petitioner is **expected** to make his transactions with the USPTO his most important business if he desires to establish "unavoidable" delay.

"Unforeseen Fault Did Occur Making the Minor Delay Unavoidable"

Petitioner argues that the Advisory Action was mailed too late to permit a timely response. According to petitioner, a timely response would have "only been possible by reversing the clocks".

37 CFR 1.135(b), the regulation relevant to the abandonment of this application, provides that (A) the admission of, or refusal to admit, any amendment after final rejection, or any related proceedings, will not operate to save the application from abandonment; and (B) the admission of, or refusal to admit, any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment. It is the applicant's responsibility to take the necessary action in an application under a final Office action to provide a complete reply under 37 CFR 1.113. "A delay is not 'unavoidable' when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action."⁸

Applicant may not rely upon late receipt of an advisory action to establish that the delay was unavoidable. 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal.

Applicant should have ensured that the amendment **had** been entered (i.e. filed an amendment *prima facie* placing the application in

⁸ MPEP 711.03(c) (III) (C) (2).

condition for allowance) or applicant should have filed either an Request for Continued Examination (RCE), continuing application, or Notice of Appeal. **An applicant should not wait to take action until receipt of an advisory action which might not even be mailed until more than six months after the mailing of the final Office action.**

"Burden of Establishing That the Delay was 'Unavoidable' Has Been Met"

As previously set forth in this decision, this burden has not been met.

"Delays Were Due to Delayed Advisory Actions, Timing Assessment Errors and Mailing Delays"

As previously set forth in this decision, the delay in this instance stemmed from applicant's failure to file a **proper** reply to the October 4, 2001 final Office action and from applicant's unfamiliarity with the rules governing extensions of time. If petitioner was incapable of filing an amendment that *prima facie* placed the application in condition for allowance, then petitioner should have filed a Notice of Appeal, continuing application, or an RCE.

"Timing Not Due to Oral Advice Nor Due to Failure to Advise in Timely Fashion"

The decision on petition dated October 3, 2002 stated that "the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action" is not grounds for petitioner to assert unavoidable delay. In other words, because the February 23, 2002 Advisory Action was not mailed within the three month shortened statutory period for reply (but still within the six month maximum period available by obtaining extensions of time), applicant can not argue that the delay was unavoidable. See the above discussion on this matter.

"Filed Were Petitions Pursuant to 37 CFR 1.137(a) OR 37 CFR 1.137(b)"

The Manual of Patent Examining Procedure states that petition fees are "required for the filing (and not merely the grant) of a petition under 37 CFR 1.137."⁹ Therefore, for the Office to even consider petitioner's argument under 37 CFR 1.137(a), the \$55 fee was necessary. Likewise, for the Office to consider petitioner's argument under 37 CFR 1.137(b), the \$640 petition fee was necessary.

"Replies to All Outstanding Office Actions Were Filed"

A proper reply to a final Office action consists of an amendment that *prima facie* places the application in condition for allowance, a Notice of Appeal, a continuing application or an RCE. Applicant has not demonstrated that he filed these replies.

⁹ MPEP 711.03(c) (III).

"A \$640.00 Fee for Reviving Patient [sic] Was Paid"

The Manual of Patent Examining Procedure states that petition fees are "required for the filing (and not merely the grant) of a petition under 37 CFR 1.137."¹⁰ Therefore, for the Office to even consider petitioner's argument under 37 CFR 1.137(a), the \$55 fee was necessary. Likewise, for the Office to consider petitioner's argument under 37 CFR 1.137(b), the \$640 petition fee was necessary.

"Statement that Delay Was Unintentional Was Made As Well As Unavoidable"

The October 3, 2002 decision did not suggest that petitioner did not make this statement. The paragraph petitioner has quoted merely states all the requirements for a grantable petition under 37 CFR 1.137(b). In fact, page 4 of the decision states that "petitioner has included a statement of unintentional delay which satisfies this requirement."

"No Terminal Disclaimer is Required"

Petitioner is correct - a terminal disclaimer is not required. The phrase "any terminal disclaimer" (as opposed to "a terminal disclaimer") was used to suggest that it only need be submitted if required. Accordingly, the fee submitted for a terminal disclaimer will be refunded to petitioner.

"Showing of Unavoidable Delay Within Meaning of 1.137(a)"

Petitioner is incorrect, and is redirected to the above discussion for an explanation as to why.

"Advisory Action Was Mailed After Final Rejection Due Date and Almost Eight Months After A Major Amendment"

Applicant may not rely upon late receipt of an advisory action to establish that the delay was unavoidable. 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal.

An applicant should not wait to take action until receipt of an advisory action which might not even be mailed until more than six months **after** the mailing of the final Office action.

"Period For Replying to Final Action Was Less Than Three Months"

As set forth above, petitioner is correct - petitioner timely responded to the October 4, 2001 Office action by filing an amendment on January 15, 2002 **with a Certificate of Mailing dated December 24, 2001**. Petitioner references a certified mail receipt. However, petitioner is reminded that it is not the certified mail receipt which made the amendment timely, but rather the Certificate of Mailing. The USPTO only recognizes Certificates of Mailing under 37 CFR 1.8, or USPS Express Mail

¹⁰ MPEP 711.03(c)(III).

under 37 CFR 1.10. No provision is made for USPS "Certified Mail".

"Telephone Call For Late Fee Was Confusing Because Our Reply Wasn't Late"

37 CFR 1.2 states that "[n]o attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt." Rather, action will be based entirely on the written record.

"Going Backward in Time Was Not Possible"

Filing a response to the October 4, 2001 Office action with an extension of time **was** still possible when the Advisory Action was mailed on February 13, 2002.

"Distinction Between Final Rejection and an Advisory Action Was Very Clear"

See the above paragraph.

"Inventor Complied With Rules That Were in Effect at the Time the Patent Was Filed"

Petitioner states that "since the inventor is a former cold war systems engineer currently trying to provide an income by book authoring and publishing, there was no time or any known reason to keep abreast of patent rule changes...." Since petitioner admits he was incapable of keeping up to date in the patent law governing his application, petitioner had another option available to him - secure the services of a registered patent attorney or agent.

"Inventor and USPTO Caught Between Changing Rules Causing Delays"

It is petitioner's responsibility to keep himself abreast of the patent laws and regulations. While the PTO will attempt to assist applicants of changes, this is done as a **courtesy** only, and does not relieve petitioner of his responsibility.

"Delays Definitely Affected Timing and We Have Proof"

Petitioner states that the USPTO has claimed that the after-final amendment was "sent" on January 15, 2002. This is incorrect. The amendment was "filed" on January 15, 2002, and was "made timely" by including a Certificate of Mailing dated December 24, 2001. See the discussion above relating to 37 CFR 1.6, 37 CFR 1.8, and 37 CFR 1.10.

Petitioner stated that the Office has not set forth new policies to account for the delays attributable to the events such as September 11, 2001. Petitioner is mistaken. Petitioner is directed to the many Notices available at the USPTO homepage at http://www.uspto.gov/emergencyalerts/index_emergency.html as an example.

"Petitioner Had No Delays Associated With 2001 Events But USPTO Did"

Unless correspondence is deposited via USPS "Express Mail", it is "filed" on the date received in the Office. However, correspondence including a Certificate of Mailing will be considered as being timely filed. Here, petitioner did include a Certificate of Mailing dated December 24, 2001, so the after-final amendment was in fact timely filed.

"Burden of Showing Delay Was Unavoidable Was Met - Unless We Were Required to Turn Back the Clock"

As set forth above, filing a response to the October 4, 2001 Office action with an extension of time **was** still possible when the Advisory Action was mailed on February 13, 2002. Petitioner could have done so by obtaining the appropriate extension of time.

"Amendment Was Filed May 23, 2001, Not on May 3, 2002"

Office records indicate that petitioner filed amendments on May 29, 2001 (mailed May 23, 2001), January 15, 2002 (mailed December 24, 2001), and May 3, 2002 (dated May 3, 2002, and presumably mailed on that date, although no "Express Mail" label number could be found).

May 3, 2002 was beyond the maximum statutory period for reply of six months. The last day petitioner could have filed a response to the final Office action mailed October 4, 2001 would have been April 4, 2001. Accordingly, the May 3, 2002 reply was not even considered by the examiner because it was not timely filed.

"Proper Reply Satisfying 1.137(a) Was Made in Petition"

Upon filing his 37 CFR 1.137(a) and 37 CFR 1.137(b) petitions, petitioner indicated that he wished the previously filed May 3, 2002 petition to be his "reply". However, the examiner has now looked at the May 3, 2002 petition and has determined that it does **not** constitute a proper reply.

Accordingly, to revive the application, petitioner will need to submit a proper reply. **A proper reply at this point will consist of the filing of either a Notice of Appeal, an RCE, or a continuing application.**

"Petitioner Requested Revival Under One or Another - Not both (a) AND (b)"

The Manual of Patent Examining Procedure states that petition fees are "required for the filing (and not merely the grant) of a petition under 37 CFR 1.137."¹¹ Therefore, for the Office to even **consider** petitioner's argument under 37 CFR 1.137(a), the \$55 fee was necessary. Likewise, for the Office to **consider** petitioner's argument under 37 CFR 1.137(b), the \$640 petition fee was necessary.

¹¹ MPEP 711.03(c) (III).

Furthermore, the petition under 37 CFR 1.137(b) was dismissed solely because petitioner failed to submit the proper reply on petition. A proper reply consists of an amendment which *prima facie* places the application in condition for allowance, a Notice of Appeal, a continuing application, or an RCE. The examiner determined that petitioner's last amendment or response, filed May 3, 2002, failed to place the application in condition for allowance.

"Petitioner Did Reply to the Final Office Action and All Other Officer [sic] Actions"

Petitioner is correct. Petitioner did file a timely reply to the October 4, 2001 Office action. However, petitioner did not timely file a **proper reply**. The reply, filed January 15, 2002 and made timely by petitioner's Certificate of Mailing dated December 24, 2001, was indicted by the examiner in the Advisory Action mailed February 13, 2002 to not be a proper reply. At that point, petitioner could have responded as late as April 4, 2002 by obtaining a three month extension of time. Petitioner did not file a proper reply by that date. Petitioner did file a response on May 3, 2002, **after** the maximum six month statutory period for reply had ended.

Conclusion:

The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable. Petitioner is **strongly recommended** to obtain the desired relief by filing a petition pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. Petitioner previously filed a petition under 37 CFR 1.137(b) on August 12, 2002. With his petition, petitioner paid the petition fee and made a proper statement of unintentional delay. No terminal disclaimer was required. However, to revive the application under 37 CFR 1.137(b), petitioner must submit the required reply. A proper reply to a final Office action at this point consists of the filing of either a Notice of Appeal, a continuation application, or an RCE. Petitioner does not get an unlimited number of chances to keep filing amendments after a final rejection.

Petitioner's delay in promptly filing a Notice of Appeal under 37 CFR 1.191, continuation application, or an RCE under 37 CFR 1.114 may be considered as evidence of intentional delay and an absolute bar to revival.

While an applicant may prosecute the application, lack of skill in the field usually acts as a liability in affording the maximum protection for the invention disclosed. Petitioner is **strongly encouraged** to secure the services of a registered patent attorney or agent (i.e. registered to practice before the U.S. Patent and Trademark Office) to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution.

The \$55 fee for the one month extension of time that was not needed to make the January 15, 2002 amendment timely, together with the \$55 fee for the unnecessary Terminal Disclaimer submitted with the instant petition, will be refunded to petitioner under

separate cover.

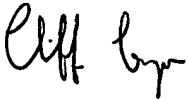
Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

By FAX: (703) 308-6916
 Attn: Office of Petitions
 Cliff Congo

By hand: Office of Petitions
 2201 South Clark Place
 Crystal Plaza 4, Suite 3C23
 Arlington, Virginia

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0272.



Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT & TRADEMARK OFFICE
Washington, D.C. 20231

REQUEST FOR PATENT FEE REFUND

1 Date of Request: <u>5/7/03</u>		2 Serial/Patent # <u>09/655,792</u>							
3 Please refund the following fee(s):		4 PAPER NUMBER	5 DATE FILED						
	Filing		\$						
	Amendment		\$						
✓	Extension of Time	7	11/15/02 \$ 55.00						
	Notice of Appeal/Appeal		\$						
	Petition		\$						
	Issue		\$						
✓	Cert of Correction/Terminal Disc.	19	11/19/02 \$ 55.00						
	Maintenance		\$						
	Assignment		\$						
	Other		\$						
		7 TOTAL AMOUNT OF REFUND \$ 110.00							
10 REASON:		8 TO BE REFUNDED BY:							
	Overpayment	✓ Treasury Check <u>CC</u>							
	Duplicate Payment	Credit Deposit A/C #:							
✓	No Fee Due (Explanation):	9 <table border="1" style="display: inline-table; width: 150px; height: 20px; vertical-align: middle;"> <tr> <td style="width: 25px;"></td> <td style="width: 25px;"></td> <td style="width: 25px; text-align: center;">--</td> <td style="width: 25px;"></td> <td style="width: 25px;"></td> <td style="width: 25px;"></td> </tr> </table>				--			
		--							
Petitioner did not need a 1 month extension to make his 11/15/02 amendment timely (he had a Certificate of Mailing). Also, a terminal disclaimer was not necessary w/ his petition									
11 REFUND REQUESTED BY:									
TYPED/PRINTED NAME: <u>Cliff Congo</u>		TITLE: <u>Petitions Attorney</u>							
SIGNATURE: <u>Cliff Congo</u>		PHONE: <u>305-0272</u>							
OFFICE: <u>Petitions</u>									
***** THIS SPACE RESERVED FOR FINANCE USE ONLY: *****									
APPROVED: <u>[Signature]</u>		DATE: <u>5/8/03</u>							

Instructions for completion of this form appear on the back. After completion, attach white and yellow copies to the official file and mail or hand-carry to: